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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

BEFORE THE HONORABLE WILLIAM H. ALSUP

ORACLE AMERICA, INC.,	)	
	)	
Plaintiff,	)	
	)	
vs.	)	NO. C 10-03561 WHA
	)	
GOOGLE INC.,	)	
	)	San Francisco, California
Defendant.	)	Wednesday
	)	April 20, 2011
	)	1:28 p.m.

**TRANSCRIPT OF PROCEEDINGS**

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(Appearances continued on next page)

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19  
20 **Also Present: John Mitchell**

1           **THE COURT:** Welcome. Please be seated. We are here  
2 for claim-construction hearing in *Oracle versus Google*, Case  
3 Number 10-3561.

4           Appearances, please.

5           **MR. JACOBS:** Michael Jacobs, of Morrison & Foerster,  
6 for Oracle. With me is Marc Peters; Andrew Temkin, in-house at  
7 Oracle; Professor John Mitchell, of Stanford University  
8 Computer Science Department; and Roman Swoopes, of Morrison &  
9 Foerster.

10          **THE COURT:** All right. Welcome to all of you. And?

11          **MR. WEINGAERTNER:** Good afternoon, your Honor.  
12 Scott Weingaertner, of King & Spalding. With me at counsel  
13 table are Bruce Baber, of our Atlanta and New York offices;  
14 Steve Snyder, of our Charlotte office; Renny Hwang, of Google;  
15 and Brian Banner, of our Austin, Texas office, who'll be  
16 arguing with me today. He's a fourth-year associate.

17          **THE COURT:** Very good. That's great. Wonderful.

18          Okay. We need to be done by 3:00 p.m., so each side  
19 has about 45 minutes. And I'll try to keep track of the time  
20 you use. You can put one minute in on one phrase, and 30  
21 minutes on another. You use it the way you want; but when you  
22 run out of time, then you sit, mute, for the remainder. So,  
23 you know, keep track of your own -- I mean, be mindful of the  
24 time that is used.

25          Now, I do have -- it's okay if you tell me why some

1 difference between you is important.

2 In other words, if you say, "This is important  
3 because the other side is trying to knock us out on  
4 invalidity," I want to know that because, even though we're not  
5 supposed to construe the claims with regard to the accused  
6 device or the prior art -- so -- or at least -- you know what I  
7 mean.

8 Now, what I have learned on this job is that, for the  
9 first five years, the lawyers would talk me into using loaded  
10 words, but not tell me why it mattered. And then, later in the  
11 trial, I would kick myself, thinking: If I'd only known how  
12 they were going to use that loaded word, I would have used a  
13 different word. So it's okay with me if you want to say the  
14 other side is trying to talk you into this word, because of  
15 this piece of prior art they're trying to avoid it, or that  
16 they're trying to bring it in, that's fine with me. So I have  
17 no problem with that, but I don't want to -- I don't want to --  
18 I mean, it's up to you.

19 Now, we will come to -- the first phrase is -- I  
20 believe it's the "reduced class files," I believe. Is that the  
21 phrase: Reduced class file?

22 **MR. JACOBS:** Yes, your Honor.

23 **THE COURT:** All right. So the plaintiff gets to go  
24 first. And you have the floor and I'll try not to interrupt  
25 you, unless I have a really good question.

1           **MR. JACOBS:** Terrific. And Mr. Swoopes will handle  
2 one of the arguments today, your Honor. He's a second-year --  
3 first-year associate.

4           **THE COURT:** First year. That's great.

5           **MR. JACOBS:** We have a set of slides. I think we'll  
6 be jumping around a little bit.

7           May I approach, your Honor?

8           **THE COURT:** You may.

9           (Whereupon a document was tendered to the Court)

10          **THE COURT:** Thank you. You have a set for my law  
11 clerk?

12          **MR. JACOBS:** I do.

13          **THE CLERK:** Thank you.

14          **THE COURT:** Great.

15          **MR. JACOBS:** So can we go to reduced class file,  
16 please?

17                 From the tutorial, I hope your Honor will recall that  
18 reduced class files are about this technique of eliminating or  
19 moving away or sharing the elements of these class files that  
20 are littering memory, and putting them in a shared location.  
21 And this was our tutorial slide that we used to illustrate  
22 that.

23                 We've got these common elements in Class 1, 2, and 3.  
24 We're going to move them into this shared space. And then  
25 we're going to refer to the common elements, rather than repeat

1 them, and unnecessarily use up memory.

2           The heart of the claim-construction dispute here is  
3 whether reduced class files are necessarily class files.

4           Our proposed definition does not repeat the  
5 expression "class file." The Google proposed construction does  
6 repeat --

7           **THE COURT:** Okay.

8           **MR. JACOBS:** -- a class file.

9           **THE COURT:** Okay. So what turns on that?

10           **MR. JACOBS:** Probably infringement, because the  
11 formal definition of a class file may not be repeated in their  
12 system.

13           We're not quite sure about how this is going to play  
14 out, because we also have a claim-construction dispute about  
15 the meaning of "class file," which we haven't teed up for you  
16 today. So there will be some second-order disputes here.

17           We're focusing today on whether "reduced class file,"  
18 read in light of the specification, is properly considered a  
19 class file.

20           And Google's argument, at bottom, is: The words  
21 "class file" appear in "reduced class file," therefore, a  
22 reduced classed file must be a reduced class file, with  
23 emphasis on "class file."

24           Actually, our view is that no formal construction of  
25 "reduced class file" is necessary. If you look at the claim

1 language -- here is Claim 1 of the '702 patent -- it says how  
2 you get to a reduced class file. And what you do is you  
3 identify the duplicated elements, and then you remove the  
4 duplicated elements from these class files, and you obtain  
5 reduced class files.

6           So what is a reduced class file?

7           Well, it's really the result of going through the  
8 steps set forth in the claim. We don't think that any formal  
9 construction is necessary; but if there is to be a formal  
10 construction, we do not believe that the term "class file"  
11 should be in that formal construction.

12           And the most important reason why that is true is  
13 that there is a formal definition of a "class file" in the  
14 specification of the '702 Patent. And that formal definition,  
15 as we'll see as we walk through the logic here -- you'll see  
16 that that formal definition is not met by the description in  
17 the preferred embodiment of reduced class files. If we don't  
18 embody -- if we don't embrace the preferred embodiment, then  
19 the construction can't be right.

20           So what does the specification tell us about class  
21 files?

22           **THE COURT:** Say that again; that the preferred  
23 embodiment would be read out of the patent if -- if Google's  
24 interpretation is correct?

25           **MR. JACOBS:** That's accurate. That's right.

1           **THE COURT:** Okay.

2           **MR. JACOBS:** So we have -- a specification tells us  
3 what a class file is. And your Honor had a question at the  
4 last hearing here: What are these thing called class files?  
5 And the specification tells us that Java classes are compiled  
6 into machine-independent bytecode class files. Each class  
7 contains code and data in a platform-independent format called  
8 a "class file format." So that is the result of compilation of  
9 a Java program: You get class files.

10           The specification also tells us that each class file  
11 is self-contained. Now, recall, this is the essence of  
12 object-oriented programming, of which Java is a species. When  
13 you program in an object-oriented programming language, you  
14 keep the data and the code that is associated with it together;  
15 and the output is a class file that is self-contained. It has  
16 what it needs to do its own internal logic.

17           That's by contrast to programming mechanisms in which  
18 the data is maintained in some data files that are referenced  
19 by the executing code.

20           So we have -- to review, we have a class file format.  
21 And a class file is self-contained.

22           Reduced class files are not self-contained, and so  
23 they can not be class files.

24           How do we know that?

25           Well, we know that what happens is the duplicated



1 elements are taken out of what will be the reduced class file,  
2 and they're put somewhere else.

3           These were necessary elements; these constants that  
4 are being moved by way of the tutorial into this shared  
5 constant pool table. They were thought, if you will, to have  
6 been necessary to this class; to this class file. And now  
7 they're being moved off.

8           So, plainly, what we're looking at here at Class 1,  
9 under individual classes on this tutorial slide from the  
10 '702 Patent -- it's no longer self-contained. Now these shared  
11 elements are up in this shared constant pool table. So we  
12 have --

13           **THE COURT:** Go back to the --

14           **MR. JACOBS:** Mm-hm? To the tutorial slides?

15           **THE COURT:** -- to the tutorial for a second, and make  
16 your point again that you were just making.

17           **MR. JACOBS:** So when we created class files through  
18 the output of a properly configured Java compiler, we created  
19 Class 1, Class 2, Class N. And these were class files because,  
20 among other things, they were self-contained. The data in the  
21 class file that's needed for that class file is there in that  
22 class file, as determined by the original programmer.

23           Let me try this analogy. I think this works. When  
24 the -- when the draftsman of each of these agreements wrote  
25 these agreements, he included all of the definitions and all of

1 the tables at the back of each agreement necessary for that  
2 agreement. These class files do not need to cross-reference to  
3 some, say, master agreement, where we're going to move the  
4 definitions or move essential terms, and then have little  
5 pieces, like statements of work, underneath a master agreement.

6 The rule that Java established is: When you're  
7 drafting, it's got to meet the four-corners rule. Everything  
8 you need for that class file should be in that class file.

9 Now, of course -- and this is Google's point -- you  
10 may have in that agreement a reference to something external,  
11 like an exchange rate, or LIBOR --

12 (Reporter requests clarification)

13 **MR. JACOBS:** L-I-B-O-R.

14 -- or the CPI, but from the standpoint of whether  
15 your contractual draftsman followed the rule, everything needed  
16 was within the four corners. There was nothing shared between  
17 the agreements, as we see in the creation of reduced class  
18 files.

19 So, by contrast, your four-corners rule got violated  
20 when we created reduced class files, because what we did is we  
21 moved the definitions and we moved the shared tables at the  
22 back of the agreement into a shared area. We put them in a  
23 master agreement. And now we're cross-referencing to them. So  
24 your four-corners rule got violated.

25 It's similar. That it is the basic concept in Java.

1 In object-oriented programming, each class is going to be  
2 self-contained. When we create reduced class files, we're  
3 going to move the shared data elements into a shared table.  
4 Very simply, they're no longer self-contained.

5 **THE COURT:** So, because they're not self-contained,  
6 you say they can't be a class file?

7 **MR. JACOBS:** Correct.

8 **THE COURT:** But why, then, are they called "reduced  
9 class files"? Why weren't they just called "reduced files"?

10 **MR. JACOBS:** It's an artifact of the drafting  
11 process.

12 To jump ahead to my favorite slide of today,  
13 Diet Coke is not Coke. The fact that Coke is used there  
14 (indicating) does not mean that the formula -- it's --  
15 Diet Coke is not merely Coke with the calories removed.  
16 Diet Coke is a different formula to create a similar taste.

17 **THE COURT:** I don't know why that's your favorite  
18 slide. I don't know. I don't understand the point.

19 **MR. JACOBS:** The point is: Using the word "Coke" in  
20 "Diet Coke" does not mean that we didn't change the formula of  
21 Coca-Cola when we created Diet Coke.

22 And, similarly, when we created reduced class files,  
23 we changed the formula. We changed the recipe. We changed the  
24 specification. We no longer conform to the recipe for a class  
25 file.

1           **THE COURT:** Well, what -- where the -- the brown  
2 items that are now in the mclass file.

3           **MR. JACOBS:** Yeah.

4           **THE COURT:** There must be something in Class 1 that's  
5 a pointer, or something that would take the place of the -- so  
6 that that would still be in there, wouldn't it?

7           **MR. JACOBS:** That's exactly right.

8           And the important point there -- and this technical  
9 analysis is not disputed by Google. They dispute the legal  
10 significance of it; but what happens is this -- as is set forth  
11 in the specification at column 9, lines 55, a new constant type  
12 replaces the duplicated element in the reduced pool, to direct  
13 constant resolution to the shared element in the shared  
14 constant pool.

15           So this is -- we've added flavoring to make this  
16 work. We've taken some things out. We've added something in.

17           And here's the real -- the technical clincher to this  
18 argument. This new constant type, which is defined with a  
19 corresponding constant type tag -- we're looking the column  
20 nine, line 55 to 65. We have a new constant type with a new --  
21 what's called an "info[]element." That's just a term in the --  
22 in Java programming. And that new info[]element is an index  
23 into the shared constant table.

24           This new constant type -- if you look at the  
25 specification of the Java class file format set forth in the

1 specification of the patent, there is no constant type that has  
2 as its info[]element an index into the shared constant table.  
3 This is something that's created not as a result of creating a  
4 Java class file, but by doing additional processing on the Java  
5 class file, to create what the patent happens to call "reduced  
6 class files."

7           So we process our soft drink to create a diet drink.  
8 And, along the way, we do some taking out, and we do some  
9 putting in; but it's no longer the original formula.

10           Google's technical description is not very different  
11 from ours. This is their slide from their technical tutorial.

12           They, too, are showing that these reduced class files  
13 have these shared elements moved into a shared constant pool  
14 table. And there's got to be a way to reference from those  
15 reduced class files to that share table.

16           That's not part -- our point; not theirs -- our point  
17 is: That's not part of the Java class file specification. So  
18 again, our point -- our basic argument on reduced class files  
19 is that we don't need to construe them. We know how we get  
20 them from the claim language.

21           Class files define a Java class, and are in  
22 self-contained class file format; but reduced class files are  
23 not in that class file format, and hence, are not class files.

24           **THE COURT:** All right. Could I try to say in my own  
25 words what I think I hear you saying?

1           You're saying that if Google's proposed construction  
2 were used, and you followed the steps in the specification, the  
3 reduced class file would not, in fact, be a class file, and  
4 therefore, the patent would cover nothing?

5           **MR. JACOBS:** That, I think, is correct. I don't know  
6 about the --

7           **THE COURT:** I didn't say that very well.

8           **MR. JACOBS:** Perfectly.

9           **THE COURT:** You're saying that Google -- if you were  
10 to do what the patent teaches somebody to do, then it would  
11 cover nothing because, according to Google's proposed  
12 construction, it would have to result in a class file. And  
13 you're -- I think you're saying that if you go through those  
14 steps, what you wind up getting is something less than a class  
15 file, so the Claim 1 would cover nothing?

16           **MR. JACOBS:** That's 99 percent right.

17           The only thing I would add to it is: You do  
18 something less and something more than a class file. You twist  
19 it in two directions. You take away things from the class  
20 file, and you add things that are not in the class-file format,  
21 and therefore, your conclusion is exactly right. It certainly  
22 wouldn't cover the preferred embodiment.

23           **THE COURT:** All right. Are you done?

24           **MR. JACOBS:** Yes.

25           **THE COURT:** Okay. We'll hear from the other side.

1           Now, if you want to do a rebuttal, that's fine. You  
2 can do it. It will still come out of your time, though.

3           **MR. WEINGAERTNER:** Good afternoon, your Honor.

4           **THE COURT:** Good afternoon. Can we give one of these  
5 to my law clerk?

6           **MR. WEINGAERTNER:** Your Honor, what we find here --

7           **THE COURT:** Wait. Wait. We've got to be on the  
8 record.

9           Okay. Now go ahead.

10          **MR. WEINGAERTNER:** We think it curious that Oracle  
11 has said that it doesn't really want to construe "class file,"  
12 and then predicates its entire construction of "reduced class  
13 file" on an apparent definition of class file; one, by the way,  
14 which very much reads in what we think is a specific Java  
15 definition of a class file.

16          We haven't proposed to construe "class file" itself,  
17 because it was --

18          **THE COURT:** All right. I know you don't, but  
19 obviously, it's in the background here. So do you disagree  
20 with Mr. Jacobs' definition of this four-corners rule, and so  
21 forth, to be a class file?

22          **MR. WEINGAERTNER:** Yes, your Honor. I think that  
23 it's -- it's a way of defining it that's very strict. And it  
24 may be --

25          **THE COURT:** Well, why are they doing that? Are they

1 doing that to avoid prior art? What's really going on here?

2 **MR. WEINGAERTNER:** It's a great question, your Honor.  
3 What we think --

4 **THE COURT:** It's just a question. I don't know how  
5 great it is.

6 **MR. WEINGAERTNER:** Well, from my perspective, it gets  
7 right down to -- what's going on here is that the -- we believe  
8 that what Oracle's trying to do is construe this term so  
9 broadly, that it will cover virtually anything.

10 When one looks at the actual language, there's almost  
11 no structure to it. A reduced class file contains a subset of  
12 the code and data contained in the class file. Technically,  
13 that includes zero. A subset includes nothing. It could  
14 include the number three. And so -- if it happened to be in a  
15 class.

16 So the idea of this term having any meaning at all --  
17 it simply washes away, and there's just no there there at the  
18 end of it.

19 **THE COURT:** Well, all right. That's a possible  
20 point, but what do you say to the opposite criticism; that you  
21 would be -- yours is so narrow, it's impossible to meet, so it  
22 would read the preferred embodiment out of the -- out of the  
23 patent?

24 **MR. WEINGAERTNER:** We don't think that's true. We  
25 think that the term "class" isn't as narrowly defined. And,



1 again, it's difficult, because "class file" wasn't really  
2 construed here; but we believe that the term that they're using  
3 is an attempt to read in, in some ways, a very narrow  
4 definition of a class for purposes of defining class, and then  
5 reading it back out again.

6 And, in fact, we've got an example. And because I'm  
7 rebutting, I'm not going to follow linearly through what we had  
8 here.

9 We do believe that the reduced class files satisfy  
10 definition of a class file format.

11 An example is -- and this goes to the issue of what  
12 exactly self-containment means. We think that a class can  
13 reach out and point to other code or things that the class may  
14 need to rely on. In fact, classes have to communicate with  
15 each other. And they can't do it if they're fully  
16 self-contained in that sense.

17 And to give you couple of examples, one is -- and  
18 this comes, I think, from the Java specification; that there's  
19 something called a "LineNumberTable attribute," that is used to  
20 point to virtual machine code that corresponds to the original  
21 Java source file. So it's an example of something that's in a  
22 class file that's actually reaching out for what it needs  
23 outside of the class.

24 **THE COURT:** Wait. Say that again.

25 **MR. WEINGAERTNER:** So, in other words --

1           **THE COURT:** So wait. Wait. So you're -- it will  
2 help me if -- I know your time is limited, but I do want to --  
3 sometimes it helps if I try to summarize what you've just said.

4           **MR. WEINGAERTNER:** Yes, your Honor.

5           **THE COURT:** You say Oracle argues that a class file  
6 must be self-contained, but that -- that's the four-corners  
7 thing that Mr. Jacobs was talking about, right?

8           **MR. WEINGAERTNER:** Right.

9           **THE COURT:** Everything's got to be within the four  
10 corners.

11           **MR. WEINGAERTNER:** Right, which -- we have a  
12 fundamental disagreement on that.

13           **THE COURT:** All right. So you disagree with that.

14           **MR. WEINGAERTNER:** Yes, your Honor.

15           **THE COURT:** And -- all right. And you say the patent  
16 itself has this example where it's not self-contained.

17           **MR. WEINGAERTNER:** Right.

18           **THE COURT:** And is that your point?

19           **MR. WEINGAERTNER:** Yes, your Honor.

20           **THE COURT:** All right. So go through the example  
21 again, and help me understand why it violates the four-corners  
22 rule.

23           **MR. WEINGAERTNER:** Okay. So again, the four-corners  
24 rule is something that we heard from Mr. Jacobs.

25           **THE COURT:** I know. I know. I'm putting that in

1 quotes, because I'm not saying it's a rule. How would I know?  
2 But that's what Mr. Jacobs said.

3 **MR. WEINGAERTNER:** Yes, your Honor; just assuming,  
4 for the sake of argument.

5 There is an attribute in this particular Java class  
6 definition, 4.7.6, which is called a "LineNumberTable  
7 attribute." And it -- again, as it says, it's used by  
8 debuggers to determine which part of the Java Virtual Machine  
9 array corresponds to a given line number in original Java  
10 source file.

11 **THE COURT:** You're going so fast, the court reporter  
12 will never get that -- okay -- but since it's up there  
13 (indicating), I guess she can.

14 Wait a minute.

15 -- "debuggers to determine...part of a  
16 virtual machine...corresponds to a given  
17 line number in the original source file."

18 So this is outside the four corners? It doesn't say  
19 "outside the four corners" there.

20 **MR. WEINGAERTNER:** Well, it's basically pointing to  
21 the original Java source code file, which is something that's  
22 not actually in the class file that's compiled down and  
23 running.

24 **THE COURT:** Does it say that in that paragraph?

25 **MR. WEINGAERTNER:** No. Used to -- again, we didn't

1 necessarily put this in the tutorial, but it's -- the original  
2 source code file is something that's external to the class  
3 that's actually being executed.

4 **THE COURT:** Okay.

5 **MR. WEINGAERTNER:** So that's one example.

6 And we think when the application was drafted, they  
7 weren't drafting it with this specific issue in mind.

8 And we -- we also think that it's -- we're not sure  
9 exactly how it is that someone reads out the terms "class" and  
10 "file."

11 Counsel for Oracle said that this was an artifact of  
12 the drafting process. We think that's probably correct. And  
13 we believe that, if something other than a class file was  
14 intended, it could easily have been labeled as such.

15 **THE COURT:** But wouldn't it be -- what's wrong with  
16 just saying, "Look. You start with a class file that everybody  
17 agrees is a class file. And then you take out something. And  
18 what's left over is the reduced class file"? What's wrong with  
19 that argument?

20 **MR. WEINGAERTNER:** Well, we think it's probably  
21 correct, but it still needs to retain something of what it  
22 means to be a class file, and not be just anything; because if  
23 we look at -- if you really carefully parse what this -- what  
24 this term goes to here, as I said before, this definition here  
25 could literally be anything. One wouldn't even know what it

1 would be limited to.

2           **THE COURT:** Wait. All right. So who is that talking  
3 there?

4           **MR. WEINGAERTNER:** Right here? The -- this is the  
5 Oracle opening brief.

6           **THE COURT:** This is -- Mr. Jacobs' own opening brief  
7 says, "Reduced class files do not satisfy the class file format  
8 specification."

9           Well, that's what he was saying a while ago.

10          **MR. WEINGAERTNER:** That's right, your Honor; but what  
11 I wanted to do was specifically -- oops. Sorry -- was  
12 specifically point to parsing this language here (indicating).  
13 And when you read it carefully, that's the point that I made  
14 earlier, but I would like to reiterate it; that it contains a  
15 subset of the code and data contained in the file. So it's  
16 something that contains a subset.

17           We don't know what that thing is. And the subset  
18 could be anything. It could actually be the absence of data.  
19 So really what they're saying is, it's just any container that  
20 may or may not contain anything. So it is devoid of meaning.

21          **THE COURT:** Why couldn't we just call it -- it was  
22 the original class file, minus what we took out and put in the  
23 common area?

24          **MR. WEINGAERTNER:** I think we would agree with that,  
25 your Honor; but I think that the notion of it being -- of it

1 retaining a class, and not just being any container with one  
2 single data point or nothing -- that's the problem that we have  
3 with that.

4 **THE COURT:** Well, you're -- you're putting weight on  
5 the fact that -- you're emphasizing the word "class." And --  
6 okay.

7 **MR. WEINGAERTNER:** No, your Honor.

8 If I could just maybe clarify, what's unusual about  
9 this definition is it uses the term "reduced class file." We  
10 should just kind of remove that, and just say it -- whatever it  
11 is -- contains a subset of the code and data contained in the  
12 class file; but there's no notion of even what that subset is.

13 So what they're saying is: It could be anything that  
14 contains a subset.

15 And the subset -- as I say, it could be data. It  
16 could be data with the number three. And there could be number  
17 three stored in any container of any kind -- would now suddenly  
18 kind of fall within this -- this construction. Kind of --  
19 collapses down to something with no meaning whatever.

20 **THE COURT:** And what if we didn't go with anybody's  
21 construction, except my own, and said, "It's the original class  
22 file, minus whatever you took out."

23 **MR. WEINGAERTNER:** Your Honor, I think --

24 **THE COURT:** In other words, the reduced class file --  
25 there's the class file you start with, and then there's the

1 reduced class file, which is what's left over after you take  
2 out the common -- common code.

3 **MR. WEINGAERTNER:** On the fly, your Honor, I think  
4 that's probably something that we could live with, although I'd  
5 like to be able to confer, if I could, about that; but I think  
6 it gets --

7 **THE COURT:** That wouldn't necessarily mean it would  
8 mean -- what's reduced wouldn't necessarily be a class, file in  
9 the sense that it would meet all of the four-corners thing. It  
10 would still have to go borrow the original -- the data that was  
11 taken out and put in the common area.

12 Well, okay. I'm taking up your time here, but you  
13 continue on.

14 **MR. WEINGAERTNER:** Well, actually, I think that  
15 really kind of got to the nub of what we were trying to argue,  
16 your Honor; that we think it's improper. We think it's kind of  
17 really cardinal error of claim construction to read out the  
18 words in the claim term, itself. We don't find any authority  
19 to support doing that.

20 We're not sure we understand the Coca-Cola analogy,  
21 although my partner, Mr. Baber, is Coca-Cola's lead trademark  
22 counsel and IP counsel, and he might be able to shed some light  
23 on whether that --

24 **THE COURT:** I'll give you an example, since I'm  
25 wasting everyone's time. Let's say you had a patent that

1 starts off with a red car. It's got a red car. And the patent  
2 deals with recoloring cars. So the phrase was, "the recolored  
3 red car." So what it's saying is: Yeah, it used to be red,  
4 but now it's been recolored, so it's not going to be red  
5 anymore. It's going to be green, or whatever; but recolored  
6 red car. It's kind of an awkward thing, but maybe the -- this  
7 phrase is a bit awkward as well.

8 And so that the key word is the "reduced" word,  
9 rather than -- and "class file" is just -- "class file" is just  
10 like one word.

11 I don't know. You know, it's frustrating that these  
12 gigantic law firms can't write a clearer language, isn't it?  
13 That --

14 **MR. WEINGAERTNER:** Yes, your Honor.

15 **THE COURT:** -- that we have to go through this  
16 process instead of --

17 All right. Anything more?

18 **MR. WEINGAERTNER:** No, your Honor. Thank you. That  
19 summarizes.

20 **THE COURT:** All right. Let's hear the rebuttal on --  
21 rebuttal.

22 So would you agree with that -- what -- my  
23 suggestion, which would be what's left over, after you take out  
24 the -- in other words, the class file minus the reductions?

25 **MR. JACOBS:** I think so. I think, just to reinforce



1 it, that is what the spec -- what the claim language tells us.

2           So again, we start with class files. They have  
3 duplicated elements. We form a shared table comprising a  
4 plurality of the duplicated elements. We remove the duplicated  
5 elements from the plurality of class files to obtain a  
6 plurality of what the patent calls "reduced class files." So  
7 reduced class files are the result of removing the duplicated  
8 elements.

9           The important point is that it's not necessarily a  
10 formal class file.

11           This reduced class file is a term --

12           **THE COURT:** Why don't you all -- or did you? Did you  
13 brief what the meaning is of the word "class"? Why did you  
14 punt that to -- kick that can down the road? Maybe that's  
15 important to deal with right now.

16           **MR. JACOBS:** It could be, your Honor.

17           And I think one of the things that has to become  
18 apparent as we have evolved towards this hearing is the  
19 importance of making you aware of where there are consequences  
20 to decisions now that -- I want to avoid surprises to the  
21 Court. And we do have differing views on "class file." And  
22 just as, again, the process of getting down to six terms  
23 unfolded, we didn't end up choosing that term to debate.

24           **THE COURT:** Mm-hm. All right. I did put limits.  
25 Okay.

1           **MR. WEINGAERTNER:** Your Honor, in the interest of  
2 possibly resolving this right now, we think we could live with  
3 the possible proposed definition your Honor mentioned, as long  
4 as it retains some notion of being a file.

5           The way we read construction --

6           **THE COURT:** Well, the word the "number three" could  
7 be a file. I know that much. You could have one little data  
8 point in a tiny little file, but it's still a file.

9           **MR. WEINGAERTNER:** We would agree that, as long as  
10 there's a file containing that, and not just the data itself,  
11 we would agree with that, your Honor.

12           **THE COURT:** Well, but no. A file can contain data only,  
13 right?

14           **MR. WEINGAERTNER:** Right, but the data itself would  
15 need to be presented as a file, and not just pure data, free of  
16 any container.

17           **THE COURT:** Well, I'm not sure I understand the  
18 distinction you're making, but you're -- Mr. Jacobs has the  
19 floor now. So --

20           **MR. WEINGAERTNER:** Yes, your Honor.

21           **THE COURT:** -- go ahead, Mr. Jacobs.

22           **MR. JACOBS:** Your Honor, I think it might be helpful  
23 if -- I want to try and help the Court get this right. And it  
24 may be that we should, following this hearing, take another  
25 shot of trying to work through this definition with the aid of

1 the Court's guidance.

2 Let's make sure we know what we mean by "file," so we  
3 don't have a dispute about the construction. That's the  
4 only -- that's the concern I have with Mr. Weingaertner's  
5 suggestion that file be intruded.

6 **THE COURT:** All right. Three more minutes. Okay.  
7 Let's go to the next phrase, which is -- which is -- it's in  
8 the '520 Patent.

9 **MR. JACOBS:** Play execution.

10 **THE COURT:** I think that's -- "the play executing  
11 step."

12 **MR. JACOBS:** Mr. Swoopes is up, your Honor.

13 **THE COURT:** All right. What's your name again?

14 **MR. SWOOPES:** My name is Roman Swoopes, your Honor.

15 **THE COURT:** How do you say that last name again?

16 **MR. SWOOPES:** Swoopes. S-w-o-o-p, as in "Peter,"  
17 "e," as in "Edward," "s," as in "Sam."

18 **THE COURT:** Thank you. Please proceed.

19 **MR. SWOOPES:** Thank you, your Honor.

20 The issue before the Court today is whether a person  
21 having ordinary skill would be able to determine the meaning of  
22 "the play executing step" as recited in Claims 3 and 4 of this  
23 patent, or whether, as Google contends, the term is indefinite,  
24 and cannot be construed.

25 Claims 3 and 4 in this patent depend from independent

1 Claim Number 1. And Claim 1, as you can see, contains five  
2 steps. It's a method for statically initializing an array that  
3 first involves compiling source code; receiving the class file  
4 that is generated from the first step into a preloader;  
5 simulating execution of the bytecodes in the class file;  
6 storing the output of an instruction requesting the static  
7 initialization of an array; and interpreting that instruction.

8 As the Court can also see, Claim 3 of the patent  
9 further refines one of the steps above, and says, "where the  
10 play executing step includes further substeps allocating a  
11 stack and performing manipulations on the stack." So, from  
12 Claim 1, we see that we basically have a one-in-five choice,  
13 even without seeing or knowing anything else.

14 And from the language "receiving" -- the play  
15 executing step doesn't sound like receiving. Excuse me. From  
16 "compiling," it doesn't look like compiling, either. There's  
17 not an overlap of work. "Simulating execution" is about the  
18 closest that one would get, without looking at anything  
19 further. And, similarly, "storing and interpreting" don't seem  
20 to, on their face, be related to play execution.

21 If we briefly look at the language of Claims 4 and 5,  
22 they follow the same basic pattern as Claim 3. They recite  
23 refinements of the play executing step. Claim 5 is not  
24 asserted in this case, however, your Honor.

25 Now, even without knowing anything more about the

1 patent, we would have a one-in-five chance of getting this  
2 right, but we see that this --

3 **THE COURT:** What is this? Russian roulette? This is  
4 a new claim construction rule: Just flip the coin?

5 **MR. SWOOPES:** Well, I make that point just simply to  
6 say, your Honor, that a person having ordinary skill has some  
7 choices in front of him or her, without having to think much  
8 about it; but in fact, it's --

9 **THE COURT:** All right. Now I see your point.

10 **MR. SWOOPES:** Yes.

11 **THE COURT:** So it's got to be one of those five  
12 things.

13 **MR. SWOOPES:** Yes, your Honor.

14 **THE COURT:** All right. So we've got to look at each  
15 one and say, "Is that one?"

16 **MR. SWOOPES:** Right.

17 **THE COURT:** "No, it's not that one." And then we go  
18 to the next one. And pretty soon, it will be down to one or  
19 two?

20 **MR. SWOOPES:** Yes, your Honor, exactly; but we don't  
21 even have to do that, because the specification makes it quite  
22 clear for us. It explicitly defines that "play executes" means  
23 "simulate executing."

24 About the only thing that the patent could do to make  
25 it clearer would be to say, "By 'play executing,' I mean

1 'simulates executing.'"

2           And we see that the specification does this in  
3 numerous places. We simply have illustrated here the summary  
4 of the invention, but if one is to simply substitute "simulates  
5 executing" into the location here of "the play executing step,"  
6 it would not change the meaning of the claim at all; the method  
7 of Claim 1, wherein the simulating -- the simulates executing  
8 step includes further substeps. It's a straightforward  
9 transformation, your Honor. It's explicitly defined within the  
10 specification.

11           I don't want to take up too much of the Court's time  
12 with this straightforward substitution, so I will -- I'm happy  
13 to answer the Court's questions.

14           **THE COURT:** All right. I want to save your time.

15           **MR. SWOOPES:** Good.

16           **THE COURT:** Good. Thank you.

17           **MR. SWOOPES:** Thank you.

18           **THE COURT:** All right. Who's next?

19           **MR. BANNER:** Thank you, your Honor. Brian Banner, on  
20 behalf of Google.

21           **THE COURT:** Okay.

22           **MR. BANNER:** Your Honor, I'm going to be addressing  
23 "the play executing step" today. It's a term, as Mr. Swoopes  
24 has said, that is in Claims 3 and 4 of the '520 Patent. And I  
25 am going to discuss why we believe that this claim lacks proper

1 antecedent basis, and why that renders it indefinite in this  
2 case.

3 **THE COURT:** Well, how can you say that? It's got to  
4 be one of those five steps, doesn't it?

5 **MR. BANNER:** Well, your Honor, our position is that  
6 that's kind of a superficial way to look at this.

7 **THE COURT:** Whenever a lawyer says, "Our position  
8 is," I know that they have some doubt about, because they --  
9 it's just their position. It's a funny thing, but the phrase  
10 "Our position is" -- just as a hint for the future -- is a  
11 signal that you are not sure of yourself.

12 **MR. BANNER:** Thank you, your Honor. I will --

13 **THE COURT:** Keep that in mind.

14 **MR. BANNER:** I'll put that in my back pocket.

15 **THE COURT:** All right. That's your position, but --

16 **MR. BANNER:** Okay.

17 **THE COURT:** -- but there's only five steps it could  
18 be. It calls out five steps. It's got to be one of those  
19 five.

20 **MR. BANNER:** Your Honor, we do not dispute that when  
21 this claim was originally --

22 **THE COURT:** The one in the middle seems pretty  
23 logical, doesn't it?

24 **MR. BANNER:** When this claim was originally written,  
25 and if you ignore the prosecution history, which is also part

1 of the intrinsic evidence, I would agree with you.

2 **THE COURT:** Yes.

3 **MR. BANNER:** But I would think that today, based on  
4 the absence of Oracle's discussion of the prosecution history,  
5 that should be a big tell as to what the deficiency in their  
6 arguments --

7 **THE COURT:** Is there something in the prosecution  
8 history that blows that out of the water?

9 **MR. BANNER:** Yes, your Honor, there is.

10 **THE COURT:** All right. Let's see that.

11 **MR. BANNER:** Claim 1, as originally filed, was filed  
12 as stating "play executing the bytecodes," which is --

13 And then Claims 3 and 4, as we said, still -- when  
14 they were originally filed, still also recited, you know, "the  
15 play executing step." However, Claim 1 was rejected by the  
16 Examiner over prior art. Claims 1 and 3 both were.

17 The parties got together. And there's a little more  
18 detailed discussion of the actual prosecution history in our  
19 opening brief, but this is the gist of it. They had an  
20 Examiner interview. And they agreed that this amendment would  
21 narrow the claims. And what they did, as shown here, is they  
22 added "simulating execution of." They deleted "play  
23 executing." And then they added, "without executing the  
24 bytecodes" as well. And so during prosecution, they changed  
25 the scope of this claim and they changed the language of



1 Claim 1.

2 Claims 3 and 4 were not similarly changed, which  
3 brings us to --

4 **THE COURT:** How did 3 and 4 read before the  
5 amendment?

6 **MR. BANNER:** Claims 3 and 4 read as Mr. Swoopes  
7 showed you in his slide. They still read "the play executing  
8 step" of Claim 1. I don't have a slide showing that.

9 **THE COURT:** Well, so at that time, it was referring  
10 to what you got there in brackets?

11 **MR. BANNER:** That's correct, your Honor.

12 **THE COURT:** So it was clear then it was referring to  
13 that language?

14 **MR. BANNER:** That is correct, your Honor. It was  
15 referring to that step at that time.

16 **THE COURT:** So then why doesn't it still refer to it?

17 **MR. BANNER:** Well, the problem is that the -- the  
18 reference to "play executing" -- not only is there -- it lacks  
19 antecedent basis, which we could just say -- well, that's just  
20 a simulating-execution step, but this was clearly a narrowing  
21 amendment. The Examiner said here in the Examiner interview  
22 that this narrowed the claims. And so because it's a narrowing  
23 of the claims, we submit that "play executing" and "simulating  
24 execution" are a not synonymous, as Oracle has argued to you  
25 today.

1 According to the --

2 **THE COURT:** A little early. Okay.

3 **MR. BANNER:** In the Examiner's mind, the Examiner  
4 required them to change "play executing" to "simulating  
5 execution," without executing the bytecodes. And that  
6 evidences the Examiner's belief that these two terms are not  
7 coextensive.

8 And so Oracle would like you to believe that these  
9 are just synonymous. We can just point back to the other one,  
10 but we submit that that is not the case.

11 **THE COURT:** But before the amendment, didn't it  
12 clearly refer to that limitation?

13 **MR. BANNER:** I would agree, your Honor, it did.

14 **THE COURT:** So isn't it more likely that it was just  
15 a screw-up, and they should have changed 3 and 4, but didn't do  
16 it?

17 **MR. BANNER:** Well, your Honor, that's one way to look  
18 at it, but there's also another problem with this -- with  
19 accepting that explanation. And that's the Oracle's proposed  
20 construction would still be indefinite.

21 This idea of, hey, it's got to be one of these -- you  
22 know, one of these steps; we're just going to point to the one  
23 that looks, you know, the most reasonable -- that sounds good,  
24 but it's really just a superficial problem that you're fixing  
25 there. And it doesn't fix more underlying indefiniteness

1 problems with Claims 3 and 4.

2 And, as we show here, they didn't amend Claims 3 and  
3 4, but they did amend Claim 1. And part of that amendment was  
4 this additional limitation that -- they say, "Claim 1, you  
5 simulate execution of the bytecodes without executing the  
6 bytecodes." So by that amendment, we when they narrowed it,  
7 they said, "We're no longer executing the bytecodes as part of  
8 this claim."

9 Well, the problem becomes, when you now look at  
10 Claims 3 and 4, you're reading a bytecode, and then you're  
11 actually performing the stack manipulation. You're performing  
12 these operations that the bytecode tells you to do. And so  
13 there's a contradiction here between Claim 1, and Claims 3 and  
14 4 that -- it just -- we cannot square, your Honor. This --  
15 this language does not make sense.

16 **THE COURT:** Well, okay. Possibly.

17 I think I see that, but if the Court were to construe  
18 "play executing step" to refer to that metal step -- the one  
19 about simulating -- would you still have your indefiniteness  
20 argument based on this language, without executing the  
21 bytecodes?

22 **MR. BANNER:** Yes, we would still have that argument,  
23 your Honor. And that's why we believe that this entire  
24 operation of trying to correct these two claims, out of the 132  
25 that have been asserted in this case, is -- is -- is a

1 rather -- we're not exactly sure why Oracle's chosen to do this  
2 here, because they still have these other problems. And their  
3 claim construction doesn't fix the problem. All it does is it  
4 highlights the fact that these types of problems -- these type  
5 of claim-drafting errors, as we briefed in our opening brief --  
6 these should be fixed by the PTO, and they should not be dealt  
7 with in this setting, where it's unclear what the patentees  
8 were trying to get at when they amended these claims.

9 **THE COURT:** All right. Thank you.

10 Any rebuttal?

11 **MR. SWOOPES:** One brief rebuttal statement,  
12 your Honor. And that is simply to say that simulating these  
13 instructions in an artificial environment does not equate to  
14 actually executing these instructions.

15 **THE COURT:** Thank you. We will now go to the next  
16 phrase, which is the '104 Patent. "Intermediate form code" and  
17 "intermediate form object code."

18 **MR. JACOBS:** So the '104 Patent, your Honor, is the  
19 resolution patent in which we -- this is the one that dates  
20 back to 1992. And it's the patent in which a symbolic  
21 reference is resolved into a numeric reference by the claim  
22 language, as illustrated in our tutorial. The process here is  
23 taking an instruction of the form LOAD Y, where Y is the  
24 symbolic reference, and converting it into the location in  
25 memory, referred to here as Slot 2, and doing that once, so

1 that when you go through that step again, you don't have to  
2 resolve the reference.

3           So my analogy for this is that if one is approaching  
4 my house at 36 Bulkley, one would be looking down the street,  
5 and looking into the house address, and trying to find it. The  
6 next time one comes to that house, it's a lot easier to  
7 remember third house on the left, and not have to look down at  
8 the what is, in effect, an address by name, rather than a  
9 location on the street. So that's the way this works. The  
10 resolved reference is relied on for subsequent execution.

11           The dispute between the two -- between the parties is  
12 actually narrow by words, but important in its substance. We  
13 have mostly aligned proposed construction for intermediate form  
14 object code. The difference is in the word "executable." And  
15 we propose that the that intermediate form object code or its  
16 variants in this patent must be construed as executable,  
17 because the specification tells us so.

18           And, in particular, in the summary of the invention,  
19 it states right up front that what we're talking about here is  
20 generating executable code, and resolving data references in  
21 the generated code. So the very first line of the summary of  
22 the invention tells us that we're talking about executable  
23 code.

24           **THE COURT:** All right. So go back to that one again.  
25 I want to --

1           **MR. JACOBS:**   Mm-hm.

2           **THE COURT:**   All right.   Thank you.

3           **MR. JACOBS:**   And then further in the specification,  
4 we are told that, under the present invention, the compiled  
5 intermediate form object code -- so that's that code that was  
6 generated by the compiler -- will achieve execution  
7 performance.   It is, therefore, executable.

8                   And if we put these two back to back, we're going to  
9 generate executable code.   And that intermediate form object  
10 code is going to achieve execution performance.   Plainly, what  
11 we're talking about is that, in conjunction with intermediate  
12 form code or intermediate form object code, is executable code.

13                   And when we look to the claims, we see that the code  
14 must be executable as well.   In Claim 22, for example, we see  
15 an apparatus containing a compiled program in intermediate form  
16 object code, and then a process configured to execute the  
17 instructions in that program.   So plainly, that program is in  
18 executable format.

19                   Now, what's going on here is that the word  
20 "intermediate" is used twice in the specification.   And there  
21 is, in compiler architecture, this concept of an intermediate  
22 representation, as illustrated here in Figure 4 of the Patent.  
23 The intermediate representation is the representation of your  
24 original program in some internal form that the compiler is  
25 going to work on along the way to creating and generating what

1 is referred to here in Figure 5 as "intermediate form object  
2 code"; but as illustrated here, plainly, the intermediate form  
3 object code is the output of this process. And, as discussed  
4 earlier, that intermediate form object code is executable.

5           So this is all about Google's attempt to read some  
6 prior art about intermediate representations; about what went  
7 on in the compiler prior art; the kind of processing and  
8 optimization that was done by way of internal compiler  
9 architectures on the very distinctive architecture -- the  
10 really highly innovative architecture -- of this patent, which  
11 is about the Java architecture.

12           And to just bring it home, what we're talking about  
13 here is executable code in the Java context; Java bytecode that  
14 executes on a Java Virtual Machine. The Java Virtual Machine  
15 is the execution platform. Within the meaning of that claim  
16 language, the Java Virtual Machine configures this process to  
17 execute the code that we submit, by definition, is executable.

18           And similarly, in Android, we have a virtual machine  
19 configuring the processor. The Java bytecode that's been  
20 translated to .dex code is in an executable format.

21           We are not talking about -- when we talk about  
22 "intermediate form object code," I'm pointing to the middle of  
23 the Java compiler box, or the Java compiler box in Java and  
24 Android. We're not talking about what happens internally to  
25 the compiler. We're talking about the output of the compiler.

1           So we both agree that intermediate form object code  
2 needs a construction. This is not a case where we are, as  
3 Google would have it, reading a limitation into the claim  
4 language. We're applying the proper construction to the phrase  
5 "intermediate form object code."

6           And the specification is quite clear, quite explicit,  
7 that what we're generating here is executable code.  
8 Intermediate form object code is to be executed, and achieve  
9 higher execution performance. And the claims themselves, when  
10 you walk through the claim language, require that the  
11 intermediate form object code be executable.

12           **THE COURT:** Is this an invalidity or an infringement  
13 issue?

14           **MR. JACOBS:** I think it's an -- because they would  
15 take the word out of our proposed definition, it's a clue that  
16 we're talking about invalidity. And, as we look at their prior  
17 art that they've provided to us, I think 90 percent of it is  
18 about compiler -- what happens inside the compiler at that  
19 intermediate representation stage.

20           **THE COURT:** All right. Let's hear from the other  
21 side.

22           **MR. WEINGAERTNER:** Yes, your Honor. We are  
23 absolutely in agreement that the only issue is whether or not  
24 the term "executable" should be read into this limitation  
25 that's up for construction. And it is an invalidity argument.



1           We should mention that all of the claims in this  
2 patent and, in fact, all of the claims in all of the patents  
3 have recently been taken up by the Patent Office. They've  
4 granted reëxamining requests on all of the claims of all of the  
5 patents-in-suit in this case, including this one, over the art  
6 that counsel for Oracle refers to.

7           **THE COURT:** When did that happen?

8           **MR. WEINGAERTNER:** It happened as recently as  
9 yesterday in one of them, your Honor. And in the last couple  
10 of days. It's happened over the last few weeks.

11          **THE COURT:** All right.

12          **MR. WEINGAERTNER:** And so somebody has concluded that  
13 the compiler art that's referred to is at least raising a  
14 question of patentability in these claims.

15           We believe that this is a very clear attempt to read  
16 a limitation into a term that doesn't have it in there; an  
17 attempt to read it from the preferred embodiment. It happens  
18 sometimes. And sometimes there's an explicit definition, and  
19 sometimes there's a reason to do that; but we don't think  
20 that's the case here. We think it's clearly a very deliberate  
21 attempt specifically to avoid the prior art.

22           And what was interesting that wasn't mentioned is  
23 that the executable modifier had previously been pending in  
24 the -- previously been in the application that led to the  
25 patent-in-suit, which was then modified by our issue, which

1 broadened the claim, and eliminated that modifier.

2           And so we think it's telling -- and it's not  
3 something that Oracle can run away from here. And I'd actually  
4 come up with a metaphor that I wanted to talk about, which  
5 involve the car that's red. And I wanted to just go through  
6 that for a moment.

7           In other words, if you claim a car in the preamble of  
8 a claim, and then later characterize that car as being red,  
9 that's fine. The car can be red; but that doesn't mean that  
10 car, in itself, is red.

11           And that's, we think, what Oracle is trying to do  
12 here. They're trying to read back in a limitation that's a  
13 feature they decided -- referred to in claims as a separate  
14 limitation referring back to the general concept of  
15 intermediate form code; but that, in fact -- if anything, that,  
16 we think, strengthens our view that it needn't intrinsically  
17 have that property. Otherwise, you wouldn't need to add it.

18           Yes, your Honor.

19           **THE COURT:** You said something I want to --

20           **MR. WEINGAERTNER:** Yes, your Honor.

21           **THE COURT:** -- right in the middle. It was  
22 explicitly deleted as a modifier. Go through the details of  
23 that argument.

24           **MR. WEINGAERTNER:** Yes, your Honor.

25           So Claim 1 of the original '685 Patent, which was

1 then actually the subject of, we think, two reissue patents,  
2 and then a continuation of a reissue -- so what we're dealing  
3 with here is sort of the second or third coming of what was  
4 originally filed. And that was done to broaden the patents.  
5 And a lot of interesting things happened which will be the  
6 subject of other things I'll raise before the Court at an  
7 appropriate time; but when you look at Claim 1 of the original  
8 patent, executable code was clearly recited, per se.

9 **THE COURT:** You mean of the application, or of a --

10 **MR. WEINGAERTNER:** The issued patent, your Honor.

11 **THE COURT:** Oh. It was issued?

12 **MR. WEINGAERTNER:** Yes, your Honor.

13 And then it was -- they attempted to correct and  
14 sought correction through a first reissue and then a second  
15 reissue, and then filed yet another application off the second  
16 reissue. This is years, now, into the life of the patent. I  
17 think it was maybe issued for five or six years when this  
18 change occurred.

19 And there was -- obviously, a lot of thought had gone  
20 into this. And one of the things that was apparently  
21 recognized as being broadening in some way was to eliminate  
22 this term, "executable" -- and in the notion of what an  
23 intermediate form object code would be.

24 We think it's telling. And we think that suggests  
25 that they needn't be the same thing; that these don't fuse

1 together automatically and permanently for all --

2           **THE COURT:** I don't -- that's '685 versus '104, but  
3 is the '104 the same patent?

4           **MR. WEINGAERTNER:** That's a -- your Honor, so what  
5 happened was -- and I apologize that we don't have a map here  
6 to kind of guide your Honor through it, although I think we do  
7 have an Elmo, and we may have the patent that I could put up  
8 there for your Honor; but just in brief, I'll try to do it from  
9 memory.

10           So the '685 Patent was filed December of 1992.

11           I think in '96, then-Sun decided to seek broader  
12 claim coverage in certain ways. And they tried to peel apart  
13 one part of the claim from another part of the claim. And in  
14 doing that, they did various things to what the claims  
15 constituted.

16           The '685 Patent was originally surrendered, so that's  
17 not in force anymore. And that's required when you seek a  
18 reissue.

19           And they filed a second reissue, broadening reissue;  
20 and then a continuation, which ultimately led to the  
21 '104 Patent which is in suit today.

22           And so what we're doing, simply, is contrasting the  
23 issued claim in the '685 Patent, which is the lead claim. And  
24 the Claim 11 here is the first asserted claim, because the  
25 other ones are no longer in the patent.

1           **THE COURT:** But what -- is Number 11 the analog to  
2 Number 1?

3           **MR. WEINGAERTNER:** That's the way we view it. It's  
4 basically the lead-off claim.

5           You know, an applicant for a patent is free to do  
6 what they want. And they could actually have broader claims  
7 down further in the chain; but it does track, in our view, the  
8 -- you know, what was -- it intended to be capturing what the  
9 alleged invention is.

10           And so the fact that executable was dropped, even if  
11 it occurs later in the claim, which it does, that gets back to  
12 the -- the metaphor of the car that is then, you know,  
13 determined to be a red car.

14           In other words, if you -- in the preamble of a claim,  
15 you refer to -- you know, earlier on in the claim you referred  
16 to it first instance of the thing that's not so limited, and  
17 then later you limit it, you're certainly free to do that, but  
18 if anything, that suggests that the first recitation doesn't  
19 require that limitation.

20           **THE COURT:** So -- but the language doesn't seem to be  
21 otherwise the same.

22           In other words, usually when this argument gets made,  
23 all of the words are exactly the same, and the word  
24 "executable" is no longer there; but the wording is totality  
25 revised. On --

1           **MR. WEINGAERTNER:** Absolutely.

2           **THE COURT:** There's no -- where -- so how do we --

3           **MR. WEINGAERTNER:** We absolutely agree, your Honor.

4 And -- because there is enormous flexibility and freedom in how  
5 people can present claims. And, in fact, that's really an  
6 issue in this case.

7           We have a disclosure that's very limited. And now we  
8 have 30-some-odd claims, all turning or independent -- I'm  
9 sorry. There are a lot of claims that all turn on different  
10 usages of the word "resolve"; but here, I think the thing we're  
11 doing is focusing in on just the use of this term itself.

12           And obviously here, there was an attempt to equate  
13 intermediate form code as being executable. And later on in  
14 the broadening reissue, because it was a broadening reissue  
15 that they trace back to the allegation to file within two years  
16 of the original issue date of the patent, although we dispute  
17 the entitlement to do that, they could have retained the  
18 executable notion with the intermediate form code object as --  
19 when they introduced it into the claim, and elected not to. We  
20 think that's evidence that the term doesn't intrinsically  
21 require being executable.

22           **THE COURT:** So you say object code does not have to  
23 be executable.

24           **MR. WEINGAERTNER:** That's correct, your Honor.

25           And we -- but this, perhaps, is a time to transition

1 to point that Oracle made about this notion that -- of  
2 intermediate representations.

3 Oracle did not put anything about intermediate  
4 representations in their definition, and sort of introduced  
5 this later as -- you know, as a different approach to try to  
6 read in a negative limitation.

7 In other words, what Oracle is trying to do is not  
8 only trying to read in a term -- executable -- but it's trying  
9 to read out, without actually putting it in the proposed  
10 construction, this intermediate form.

11 And we don't believe that that's -- well, first of  
12 all, we don't believe it's proper to try to construe a term  
13 without literally putting it into the language that the jury  
14 will see, because the jury will be left, I suppose to, to sift  
15 through the briefs to figure out what exactly this is going to  
16 mean. We think that is a bit of a red herring. And we think  
17 it's just a simple attempt to -- again, to read a limitation in  
18 from the claim that isn't required. It's not defined. And  
19 again, we believe the prosecution history makes fairly clear  
20 that it needn't be there.

21 **THE COURT:** Okay.

22 **MR. WEINGAERTNER:** That's our position.

23 **THE COURT:** Thank you, your Honor.

24 **MR. WEINGAERTNER:** Thank you, your Honor.

25 **THE COURT:** All right. Go ahead.

1           **MR. JACOBS:** The problem with Google's definition is  
2 that it does nothing with object code. And object code is  
3 understood to be executable. And that's why we included  
4 executable code in our proposed definition.

5           In Google's definition, object code is not -- the  
6 object in object code is missing. The prosecution history is  
7 much more complicated than to show -- than as, really, Google's  
8 counsel explained.

9           What the -- what the applicant did -- what Gosling  
10 did in the reissues was separate out what was happening on the  
11 compiler side from what was happening on the -- if you will,  
12 the user computer side.

13           You recall the first claim was a system for  
14 generating, and then for executing. And if you look at -- as  
15 we explained in the brief, what happens during the reissue is  
16 he realizes: Wait a minute. I better claim separately what's  
17 happening on the server side of things and what's happening on  
18 the user computer.

19           So the word gets changes to "intermediate form object  
20 code"; but we still have to construe intermediate form object  
21 code. And the best fit -- the definition that comports with  
22 the specification -- is executable code. Google's construction  
23 doesn't explain what happened to the object in object code.

24           **THE COURT:** All right. Let's go to symbolic  
25 reference.



1           **MR. JACOBS:** We will be saying in a couple of places,  
2 your Honor, that the claim language is sufficiently clear that  
3 construction adds unneeded complexity; but if construction must  
4 be had, we have a proposed construction.

5           And that is true with "symbolic reference." We think  
6 that a symbolic reference is clear in the claim, and that it  
7 doesn't need to be construed; and that Google's proposed  
8 construction adds a whole lot of confusion and unnecessary  
9 complexity. So symbolic reference is in the claims by -- in  
10 relief against numeric reference.

11           And so what we see in Claim 17, for example, is that  
12 we're going to resolve the symbolic references to a numeric  
13 reference. And, although we haven't teed it up to you the  
14 construction of numeric reference, we know that a numeric  
15 reference is a location in memory.

16           Recall Slot 2. So Slot 2 is the numeric reference in  
17 the illustration. That's a location in that table. It's a  
18 location in memory. The Y is the symbolic -- is the symbolic  
19 reference there. So once you know that you're resolving a  
20 symbolic reference to a location in memory, the symbolic  
21 reference is a reference by symbol; but if we have to construe  
22 it, then let's look at what the specification tells us.

23           And what the specification tells us is that the  
24 symbolic reference is in the form of a name. So in the  
25 illustration that we were looking at in Figure 1, the LOAD

1 instruction references the variable Y by the symbolic name "Y."

2 So a symbol is a name.

3 Google relied on a dictionary: The Microsoft  
4 Dictionary. And this, too, helps us understand the  
5 relationship between a symbolic reference and a numeric  
6 reference.

7 And, in particular, if you look at the definition of  
8 "symbolic address," not perfectly aligned with "symbolic  
9 reference," but I think the definition helps us understand  
10 what's going on.

11 A symbolic address is a memory address  
12 that can be referred to in a program by  
13 name, rather than by number.

14 Now, what kind of number are we talking about?  
15 Because, plainly, a symbolic reference can include a number.  
16 It could be Y2 or Y3.

17 Well, this rest of the definition helps us understand  
18 that.

19 "The interpreter compiler or assembler"

20 --

21 In our invention here, it's the interpreter.

22 -- "translates the name into the number  
23 that specifies the address."

24 So symbolic reference into numeric reference; and  
25 reference by name into a reference by location in memory.

1 Google proposes to add "dynamic," because the  
2 specification -- the authority for that is that the  
3 specification says the data reference is static -- i.e.,  
4 numeric -- or dynamic -- i.e., symbolic.

5 And so in interpreting "symbolic reference," they  
6 propose to add in the word "dynamic"; but the specification  
7 chose -- the patentee chose the word "symbolic" for the claims.  
8 And to say that dynamic equals symbolic, therefore symbolic  
9 should mean dynamic doesn't help us at all. What does  
10 "dynamic" mean?

11 And what -- we end up in this kind of a circular  
12 loop, where, if we have "dynamic," well, what does "dynamic"  
13 means? It means "symbolic." So "symbolic reference" means  
14 "symbolic reference," which just got us back to where we  
15 started from.

16 That's probably the proper role of "dynamic," but  
17 "dynamic" is one of those words in the computer arts that has  
18 infinite meanings. It's a highly elastic term.

19 Google also proposes to add string- or  
20 character-based.

21 Well, what is that all about? Is it designed to  
22 exclude some kind of a symbolic reference, where the symbolic  
23 reference is a reference by name?

24 We're not really sure where they're going with this,  
25 but the jury's going to have to be taught what a string- or

1 character-based reference is, if Google's construction is to be  
2 adopted.

3 **THE COURT:** I'm -- this is confusing me. I'm sorry.

4 **MR. JACOBS:** Okay.

5 **THE COURT:** Give me, in very simple terms, where you  
6 two disagree. I've lost that point.

7 **MR. JACOBS:** We disagree, in that we propose that a  
8 symbolic reference is a reference by name, if we're going to  
9 construe the term.

10 They propose that "symbolic" is a dynamic reference  
11 to data that is string based or character based.

12 **THE COURT:** What's the difference between that?

13 **MR. JACOBS:** Well, what does "dynamic" mean?

14 In the specification, it says that it's symbolic. So  
15 that doesn't help us, because we were construing "symbolic  
16 reference" --

17 **THE COURT:** Give me a concrete example where it would  
18 fit yours, but not theirs, and vice versa.

19 **MR. JACOBS:** I don't think we know yet. I don't  
20 think we know exactly where they're going, honestly.

21 **THE COURT:** Where are you going? Give me an example  
22 that you think fits your definition.

23 **MR. JACOBS:** Here's where we're going: The Android  
24 code.

25 So the Android code has a routine. It's the class.c

1 routine. And it says, "We're going to link and resolve." And  
2 it says, "This converts symbolic references into pointers."

3 So this -- we think that what is -- is a symbolic  
4 reference here is clear to the ordinary programmer; the  
5 ordinary person in the art.

6 Where they're going with their definition to say,  
7 "This symbolic reference is not a symbolic reference," we're  
8 not sure. We don't have the full ventilation of their  
9 noninfringement contention here. It must have something to do  
10 with "dynamic" and "string based" or "character based," but  
11 since the word "symbolic reference" is used right in the code,  
12 we don't think there's any trouble by saying, "A symbolic  
13 reference is a symbolic reference," or, at worst, if one has to  
14 construe it, it's a reference by name, which is what the  
15 specification tells us. So we think it's clear. The claim  
16 scope here is clear, without a construction of symbolic  
17 reference.

18 **THE COURT:** You don't want a definition, because  
19 you've got -- is that their own document?

20 **MR. JACOBS:** It is. It's the Android code, your  
21 Honor.

22 **THE COURT:** It uses the claim language right there.  
23 So you're happy with that.

24 **MR. JACOBS:** Very.

25 **THE COURT:** But they -- they're not happy with that,

1 and they would like to have it larded up with some other  
2 definitions.

3 **MR. JACOBS:** Like "dynamic," and "string-," and  
4 "character based."

5 **THE COURT:** Well, I don't know the answer to this,  
6 but you know, each of you are saying that certain -- why don't  
7 you have a tradeoff? Why don't you each agree that we won't  
8 give a definition; you'll let them just fight it out in front  
9 of the jury; and each of you give one where there's no  
10 construction.

11 **MR. JACOBS:** I think that's a terrific idea.

12 **THE COURT:** I had a case once where the lawyers  
13 agreed that we would construe nothing. It would just be fought  
14 out like the O.K. Corral front of the jury. And it was great.  
15 They both wanted it that way.

16 **MR. JACOBS:** And the sentiment underlying this is  
17 that this claim-construction process -- and I think this case  
18 illustrates it -- has, to some degree, taken on a life of its  
19 own.

20 If we have code that says "symbolic reference," and  
21 we have a claim that says "symbolic reference," why are we  
22 construing some --

23 **THE COURT:** That's an excellent jury argument, but it  
24 could be -- there have been cases where, you know, words don't  
25 mean what they say.

1           **MR. JACOBS:** But then you should have a very clear  
2 signal that we're doing something to narrow "symbolic  
3 reference." And we don't see that in the specification.

4           **THE COURT:** All right. Okay. All right.  
5 What do you say to that?

6           **MR. WEINGAERTNER:** Well, your Honor, we believe that  
7 the proposed definition that we have --

8 And I've got my pointer here.

9 -- actually provides some guidance for the jury that  
10 they wouldn't otherwise have, and does so in a way that's very  
11 consistent with the specification. We think the fact that the  
12 parties differ to some extent suggests that they really should  
13 be construed, although I'm sure we would have no problem  
14 battling it out, as your Honor suggested, in court.

15           **THE COURT:** But how would you get around the fact  
16 that your own document says "symbolic reference"? That's the  
17 code; the claim language. So then you would have to say,  
18 "Well, yeah, that's what -- they do say the same thing, but  
19 'symbolic reference' in the patent means something different."

20           **MR. WEINGAERTNER:** Well, your Honor, I guess just a  
21 couple of quick comments on that. We got an e-mail yesterday  
22 from counsel saying that they intended to introduce this today.  
23 We hadn't heard that from them earlier.

24           **THE COURT:** Introduce what?

25           **MR. WEINGAERTNER:** The code that they flashed up on

1 the screen --

2 And, just as a matter of mechanics, when we were last  
3 before your Honor two weeks ago, we'd agreed that we would  
4 supplement our noninfringement contentions next week. And so  
5 in some ways, we think it's maybe a little bit premature to  
6 refer to "comments."

7 That's not actual code, by the way. That's comments  
8 from the inventor that --

9 **THE COURT:** Yeah. Comments. Right.

10 **MR. WEINGAERTNER:** -- may or may not be probative,  
11 and that may or may not be relevant here. And so our point is  
12 that a juror might not have a sense of what this actually  
13 means.

14 We don't believe that string- or character based is  
15 difficult for a jury to comprehend. We think it provides  
16 useful guidance. And that's consistent with the specification,  
17 and would help them apply that language.

18 We think that Oracle actually concedes that the  
19 specification defines what it is to be symbolic. And we think  
20 that their definition would read that limitation out, and  
21 somehow broaden it, and perhaps be confusing, because there's  
22 something actually quite subtle here about the distinction  
23 between "symbolic" and "numeric."

24 I was actually going to use an example, your Honor,  
25 if I might. And there was several kind of commonplace examples



1 that Oracle uses in its papers.

2 I think you could think of the distinction between  
3 symbolic and numeric as imagining baseball players, for  
4 example, in the Giants, who have a number on their back. The  
5 number on their back has some identity for maybe who they are,  
6 but it has no role on where they actually appear in the field.  
7 So Tim Lincecum has "55" on his back, but he actually goes, at  
8 some point, to Fielding Position Number 1. And Buster Posey  
9 has "28" on his back, and goes to Position Number 2, unless the  
10 manager decides maybe he should go somewhere else.

11 And so the number on their back would be symbolic in  
12 some way of who they are, but it doesn't ultimately fix where  
13 they end up on the field, which would be kind of a rough  
14 metaphor for the memory. And we think that it's difficult for  
15 a jury to tweeze those things apart, and that it's the string  
16 nature and the dynamic nature -- "dynamic" meaning you don't  
17 know where that person's going to go; you don't know where that  
18 data's going to end up. It's not static.

19 And that's basically -- we're actually referring to  
20 the same text that Oracle did that makes very clear that the  
21 numeric and static -- and "i.e." is actually a direct equation.  
22 I'm not a Latin scholar, but I think it means "that is." So I  
23 don't think there's any question about whether they're  
24 basically interchangeable. And the same goes for "dynamic."

25 You know, I guess we're hoping that the jury will

1 understand the "dynamic" means, you know, in motion in some  
2 way, and not fixed or static. We believe those terms are  
3 relatively well understood.

4 **THE COURT:** Well, just looking at that, static --  
5 "main interpretation determines if the data reference is  
6 static; i.e., numeric." So that -- that seems to be equating  
7 "static" with "numeric"; like, say, the number 7.

8 And then it says "or" -- which I read there to mean  
9 "versus -- "dynamic equates to symbolic"; like in Y, or Y2.  
10 You could have Y2?

11 **MR. WEINGAERTNER:** Yes, your Honor. Yes, your Honor.

12 **THE COURT:** All right. X1. And -- but that would  
13 be -- if you just had one, that would normally be thought of as  
14 numeric; but if you have X1, that would be symbolic, right?

15 **MR. WEINGAERTNER:** That's right, your Honor. And so  
16 that's why, down here, we give an example of, you know,  
17 Object 3 contains -- it's a string. It's human-readable. It  
18 contains a number, for sure; but it's not numeric in the narrow  
19 sense that's required here in this field. This field uses  
20 these terms differently, we think, than it is necessarily used  
21 in other contexts.

22 This notion of static and numeric -- it's not  
23 completely obvious to somebody who's not familiar with this.  
24 And because numeric has more to do with an ultimate location --  
25 and there's actually, you know, some disclosure in the patent

1 that is helpful there.

2           So in the description here -- and this is looking  
3 back at the prior art, because this is, again, not anything  
4 that was specific to Sun when they filed their application.  
5 The numeric reference here -- as you can see, 2 is -- actually,  
6 it's not merely a string. It's not merely a label. It's not  
7 merely a number on a ball player's back. It's actually  
8 where -- it relates to where something will actually reside  
9 that's known; whereas symbolic reference here, although it's  
10 very difficult to tell from this figure because it's not  
11 dynamic enough, in a way, this really could wind up being  
12 anywhere. It's not a specific known slot. "Slot" here  
13 actually means this slot, per se.

14           And so what we've tried to do is to create some -- a  
15 tool kit for the jurors to somehow tweeze apart this pretty  
16 subtle distinction. And we think that reference by name  
17 doesn't really get the jury there.

18           **THE COURT:** Go back and show me the claim language  
19 that's at issue here.

20           **MR. WEINGAERTNER:** (Indicating)

21           **THE COURT:** No. I mean --

22           **MR. WEINGAERTNER:** I'm sorry.

23           **THE COURT:** That's just too -- of course, I don't  
24 know. In context.

25           **MR. WEINGAERTNER:** I'm sorry, your Honor. I'm not --

1           **THE COURT:** The claim itself.

2           **MR. WEINGAERTNER:** Okay.

3           **THE COURT:** That's all your argument, but where's the  
4 claim?

5           **MR. WEINGAERTNER:** We don't have a copy of the claim  
6 in our slides today, but --

7           **THE COURT:** Well, why not? Somebody must have that.  
8 All right. Does somebody have the patent handy?

9           Oh, wait. I do have the patents. Okay. Which  
10 patent are we talking about here?

11           **MR. WEINGAERTNER:** Your Honor, it's the '104 reissue  
12 patent.

13           **THE COURT:** Is that it right there?

14           **MR. WEINGAERTNER:** Yes, your Honor.

15           **THE COURT:** '104.

16           (Reading)

17           "Apparatus comprising a memory  
18 containing intermediate form object code,  
19 constituted by a set of instructions,  
20 certain of said instructions containing one  
21 or more symbolic references and a processor  
22 configured to execute said instructions  
23 containing one or more symbolic references  
24 by determining a numerical reference  
25 corresponding to said symbolic reference,

1 storing said numerical references, and  
2 obtaining data in accordance with said  
3 numerical references."

4 Now, ordinarily, just without the benefit of  
5 anything, I would read that to mean -- okay -- symbolic  
6 reference is, like, Y; and numerical reference is, like, 7.

7 So do you have the instructions that would contain a  
8 reference to, say, Y? Or it could be Y1. And somewhere it's  
9 storing the number -- whatever number you want -- 99 -- to  
10 correspond to that symbolic reference. I don't know.

11 Why -- is that -- whose argument is that, or is that  
12 nobody's argument?

13 **MR. WEINGAERTNER:** I believe that's Oracle's  
14 argument, your Honor. And I think that --

15 **THE COURT:** What's wrong with that argument, then?

16 **MR. WEINGAERTNER:** What's wrong with the argument,  
17 your Honor, is that a juror could look at symbolic -- see  
18 numbers -- it could be actual numbers or numerals -- and think  
19 it's a numeric reference, but it's actually symbolic.

20 **THE COURT:** No. Wait. No. Wait, wait. But if you  
21 have the number 99 -- but see it says, further down there, "by  
22 determining a numerical reference corresponding to," so it's  
23 distinguishing between numerical and symbolic.

24 **MR. WEINGAERTNER:** I know that's right, your Honor;  
25 but if a juror were to see something that was actually -- that

1 contained numbers without any guidance, I think they could  
2 think that was numeric, but it wouldn't be. It would be merely  
3 symbolic. And I'd refer back to the baseball analogy.

4           **THE COURT:** But how could it be that a computer  
5 recognizes numbers as numbers? If you just got 99, it treats  
6 that as -- it doesn't treat it as a variable. It treats it as  
7 an absolute number; but if you have Y99, it treats that as a  
8 variable. You define it. It will recognize that. That's what  
9 I think. Anyway, it would recognize Y99 as a variable. You  
10 could then equate it to whatever you want it to be, for  
11 purposes of the next step in the process. And then maybe for  
12 the next step, you say, "Okay. Now it's going to be 150." And  
13 it varies. It's a variable. It's dynamic.

14           And -- but if you have just 99, is the way I  
15 understand computers work, it sees 99. It treats that as an  
16 absolute Arabic number. And -- you know, like from zero to  
17 infinity.

18           Isn't that the way it works?

19           **MR. WEINGAERTNER:** That's exactly the subtlety,  
20 your Honor, that we're trying to deal with here, because -- and  
21 again, that's why I used the baseball analogy. You could look  
22 at the back of somebody's uniform and see this number and  
23 think: Oh, that's numeric. And again, the metaphor is that:  
24 Where do they ultimately end up? Where does that data end up?  
25 It ends up somewhere in the computer statically.

1           **THE COURT:** But a baseball diamond is one thing, but  
2 the computer is set up to -- to recognize 99 as a real,  
3 absolute number. It's not treating that as a position on the  
4 baseball field.

5           **MR. WEINGAERTNER:** Well, I would disagree,  
6 your Honor. I could, if I wanted to, set up a variable: One,  
7 two, three. That just is a name of a procedure that I call  
8 "one, two, three." That does something else.

9           **THE COURT:** One hyphen, or one twenty-three?

10          **MR. WEINGAERTNER:** Oh, yeah. I could name the  
11 variable whatever I want to.

12          **THE COURT:** I don't think you can. I don't think --  
13 unless it's in quotes or something, I don't think a computer  
14 will recognize one, two, three, as anything other than  
15 one hundred twenty-three.

16          **MR. WEINGAERTNER:** No. I think there's a distinction  
17 between the variable and the data that's ultimately pointing  
18 to. And that's -- it's a -- that's exactly, exactly what we  
19 think the problem is.

20          **THE COURT:** I don't think you can have a variable  
21 that's just straight out one, two, three, run together. Where  
22 does it say you can do that in this record?

23          **MR. WEINGAERTNER:** I don't think the patent  
24 necessarily says it. I think that what the patent does is  
25 provide for that situation by drawing a distinction between

1 dynamic and static.

2           **THE COURT:** But that language you showed me  
3 earlier -- go back to that language. Yeah, right there. It  
4 says, "static; i.e., numeric." So that's on one side of the  
5 equation -- not equation -- but one side of the distinction  
6 that's being drawn.

7           And then there's a big divide or -- versus dynamic  
8 and symbolic, are the ones that are on the other side.

9           So I -- to me, "numeric" means, like, 125 or 99.

10          Static -- it doesn't change, but dynamic is like a  
11 variable, like Y.

12          **MR. WEINGAERTNER:** Your Honor, I think -- I  
13 apologize.

14          **THE COURT:** It can't change. That's why it's called  
15 "symbolic." It's like X squared equals Y squared equals Z  
16 squared.

17          **MR. WEINGAERTNER:** The issue, though, in terms of  
18 static is where the data ultimately resides. And a variable  
19 that hasn't been resolved doesn't know where it's going to be  
20 yet. It's dynamic. It can move around. That's again why I  
21 used the baseball analogy. Everybody is ultimately a fielder  
22 on the field. And they have their position. And that position  
23 has a number. Pitcher is number one. Catcher is number two.  
24 That's fixed for all time.

25          Where an individual player might wind up, you don't



1 know. They have a number on their back for sure. That's a  
2 number on their back, but it doesn't tell them where on the  
3 field they're going to go.

4 So, similarly, a variable may have numbers in it, but  
5 you don't know exactly where it's going to be in the computer.

6 **THE COURT:** It's a pretty good jury argument. Again,  
7 I like that.

8 All right. We are running out of time. We've got  
9 about ten minutes to go. So do we have any more to construe  
10 here? I think there's one more, isn't there?

11 **MR. JACOBS:** On the '104 Patent, your Honor, it's  
12 "resolving."

13 **THE COURT:** Yes. Let's go to that one. We really  
14 got to -- you're -- you have about nine minutes left,  
15 Mr. Jacobs; but I don't see how I can get it done. I'm going  
16 to give you five minutes.

17 **MR. JACOBS:** Thank you, your Honor.

18 **THE COURT:** All right. Go ahead.

19 **MR. JACOBS:** Once again, we think the claim language  
20 is clear. And this -- in this case, "resolving" -- if you look  
21 at the claim language, it actually breaks out what is being --  
22 what is meant by "resolving." And it varies from claim to  
23 claim as to how much elaboration and limitation on the  
24 "resolving" step is meant in each case.

25 And what Google wants to take -- do is take one of

1 those incidents of "resolving," and propose a construction  
2 based on it that has this notion of replacing.

3 We want -- again, we submit no construction is  
4 necessary, but at most, with -- with a construction of  
5 "resolving," "determining" is as far as one can go and get a  
6 fit to the claims and specifications.

7 **THE COURT:** You have that word in their comment  
8 sections in the opposing code? Is that why you want the word  
9 "no construction"? You got that one there, too?

10 **MR. JACOBS:** We do have that word there, your Honor.

11 **THE COURT:** That's what I figured. See how  
12 transparent all of this is? It's -- all right.

13 **MR. JACOBS:** And we'll show it to you. We're  
14 transparent. Well, almost transparent.

15 If we go to Claim 20, for example, Claim 20 says  
16 we're going to resolve the symbolic reference -- there's that  
17 expression again -- in the instruction by determining a  
18 numerical reference corresponding to the symbolic reference.

19 **THE COURT:** Let me just see. I want to read it out  
20 loud. Is this one of the ones at issue?

21 **MR. JACOBS:** Sure. It's one of the ones at issue.

22 **THE COURT:** Twenty?

23 "A computer-implemented method for  
24 executing a compiled program containing  
25 instructions in an intermediate form code,

1 at least" --

2 Let me just think about that. All right.

3 -- "at least one of the instructions  
4 containing a symbolic reference" --

5 So, like, that would be what I was saying a minute  
6 ago, like why, right?

7 **MR. JACOBS:** Yes.

8 **THE COURT:** (Reading)

9 -- "said method comprising the steps of  
10 resolving the symbolic reference in the  
11 instruction by determining a numerical  
12 reference corresponding to the symbolic  
13 reference."

14 Well, let me just stop for a second. I know that way  
15 before this patent ever came along, computer programmers were  
16 able to -- the computers would find if you were using Y or X1;  
17 whatever was your variable. It would go determine a numerical  
18 reference. That can't possibly have been a new invention.

19 So -- but what you're telling me is that you say  
20 that's what it means, is doing that old, traditional step in  
21 this -- in the context of this lead-in language that you have  
22 up there?

23 **MR. JACOBS:** Yes, your Honor, with one qualification.  
24 I think I'm going to help Google's counsel out here just  
25 slightly. When we're talking about numeric reference in

1 this -- in the context of these claims, we are talking about a  
2 numerical reference to a location in memory.

3 **THE COURT:** Oh. So you're not -- so it's not, like,  
4 one twenty-five.

5 You're saying it does have to be, like, a number in  
6 the -- a number in the stack, or whatever the right word is.

7 **MR. JACOBS:** Yeah. Slot 2, again, by analogy; by  
8 reference to the specification.

9 **THE COURT:** By analogy.

10 You're saying it has to be -- let me see if I get  
11 that. Okay.

12 -- "comprising the steps of resolving  
13 the symbolic reference in the instruction  
14 by determining a numerical reference" --  
15 So this would be like Slot 2 or Slot 125?

16 **MR. JACOBS:** Exactly.

17 **THE COURT:** (Reading)

18 -- "corresponding to the symbolic reference."

19 So it could return something other than a number? In  
20 your view, then, it could return a number? It could return any  
21 kind of a symbol?

22 **MR. JACOBS:** In the numerical reference, it could  
23 return a pointer. It could return something that tells you  
24 where in memory to go; whereas Y is completely agnostic, if you  
25 will, as to where it sits in memory.

1           And the key is, if you want to -- the textual support  
2 for this in this claim language is: We're going to perform an  
3 operation with the instruction and data obtained in accordance  
4 with the numerical reference -- and then this is the heart of  
5 it in the context here -- without recompiling.

6           So we're going -- in this computer-implemented method  
7 for executing intermediate form code, we're going to resolve  
8 the symbolic reference to get the numerical reference location  
9 and data, and then we're going to -- then we're going to  
10 perform the operation in accordance with --

11           **THE COURT:** But you still agree that the red,  
12 highlighted language there -- that was in the prior art?

13           **MR. JACOBS:** Resolving symbolic references in  
14 instructions by determining numerical references?

15           **THE COURT:** Yes.

16           **MR. JACOBS:** On a stand-alone, basis? Yes.

17           **THE COURT:** All right. So then go ahead.

18           **MR. JACOBS:** So on this theme, though, that the  
19 concept of resolving is explicated in each of the claims in  
20 varying ways is evidenced by Claim 12, where we're going to  
21 resolve. And it's going to have two substeps. It's going to  
22 determine; and in this case, it's going to store.

23           Now, recall Google's proposed construction. Their  
24 proposed construction is "replace." They want to overwrite the  
25 original instruction. And they want to limit "resolving" to

1 this replacement.

2           There is a claim in which replacing occurs:  
3 Claim 14. It's a dependent claim. The method of Claim 3,  
4 wherein said substep of storing comprises the substep of  
5 replacing -- but if "resolving" always means "replacing," then  
6 we have a huge claim-differentiation problem. There's no  
7 purpose to Claim 14.

8           **THE COURT:** Well, what more does it mean, beyond  
9 replacing?

10           **MR. JACOBS:** Pardon me?

11           **THE COURT:** What else could it be, other than to  
12 replace?

13           **MR. JACOBS:** It could be to hold somewhere else in  
14 memory, but not overwrite.

15           As long as we rely on the "resolved" reference, we  
16 don't have to -- we don't have to erase the original variable.  
17 We don't have to erase the symbolic reference. As long as the  
18 computer knows I'm going to now go to the third house on the  
19 left, I didn't have to wipe out 36 Bulkley from my home  
20 address.

21           **THE COURT:** All right. Time's up.

22           **MR. JACOBS:** Okay. Thank you, your Honor.

23           **THE COURT:** Last word.

24           **MR. WEINGAERTNER:** Thank you, your Honor.

25           We hope to construe the configured medium, but we

1 maybe don't have a chance on this go-around.

2           So the points that were made by Oracle's counsel have  
3 to do with the presence of reading and rewriting together in  
4 the specification -- I'll just grab my pointer -- as showing  
5 some sort of distinction between them, which would be fine,  
6 except for the prior art that's admitted in the patent.

7           The prior art that's admitted in the patent basically  
8 has to do -- and this was actually something that came up  
9 during the tech tutorial. Counsel for Oracle basically was  
10 forced to admit that the hybrid solution -- this is this patent  
11 that we're talking about here -- is to -- quote, unquote --  
12 "resolve" this symbolic reference; but the next time around,  
13 subsequent times rely on the previous resolution, which  
14 requires -- at minimum, requires storing of some sort; and we  
15 believe requires replacing.

16           The construction that's been presented doesn't have  
17 that in there at all. There's nothing to do with that.

18           It's basically determining. And who knows really,  
19 even, what that means. In fact, "determining" was actually not  
20 used in the original filing.

21           **THE COURT:** So wait. Go back to your -- you're  
22 saying, then --

23           **MR. WEINGAERTNER:** What we're saying, your Honor, is  
24 that the only way to fairly read this term -- and that the  
25 claim that was shown earlier that raised potential issues of

1 prior art -- that they really do raise those issues. And this  
2 is why Patent Office has found a substantial new question on  
3 precisely that language. The only way to really understand it  
4 is by looking at this figure and considering the prior art;  
5 that "resolving" in a vacuum, without any kind of replacement  
6 or rewriting at -- and this, by the way, is the core. This is  
7 really the entirety of the disclosure of what's allegedly  
8 patentable here. It's -- it's really hard to distinguish  
9 between -- between "resolving" and "rewriting." They seem to  
10 be the same thing.

11           Sure, they break them out into different words. That  
12 presents an issue. We recognize that issue, but we feel the  
13 only way to really deal with it and resolve, so to speak, is by  
14 recognizing this; by recognizing that the prior art doesn't  
15 allow you not to actually write it down and replace; and that,  
16 in fact, what's interesting is that there were claims in the  
17 patent -- Claims 12 and 13 -- that actually define "resolving"  
18 as including storing; but yet the definition that's proposed  
19 again miraculously disappears from the definition. It doesn't  
20 require it.

21           So we're not sure. We actually believe, your Honor,  
22 at some point, we will hopefully have a chance to explain to  
23 your Honor some of the real problems with the way the claims --  
24 during this reissue process -- it stores the claims that go to  
25 all kinds of nuances that are not actually shown here. There's



1 something very interesting going on with these claims that I  
2 think leads back to this problem: What does it mean to  
3 resolve?

4 The only way we think it can be fairly construed is  
5 by taking into account that you have this rewriting; that you  
6 don't have this problem of having to do deja vu over and over  
7 again, and figure it out over and over again. You have to  
8 somehow replace it.

9 **THE COURT:** Okay. I've got a couple of questions for  
10 you all; both of you.

11 Do you still think that on the first one we  
12 discussed, there is at least a 50:50 chance you could agree on  
13 a meaning?

14 **MR. WEINGAERTNER:** I do, your Honor. And I think it  
15 comes down to including some notion of a file in that term; and  
16 that we could agree to that claim construction.

17 **THE COURT:** All right. Well, if I give you until --  
18 today is Wednesday. If I gave you until Monday at noon, could  
19 you let me know by then, if you've been able to do that?

20 **MR. WEINGAERTNER:** Yes, your Honor.

21 **MR. JACOBS:** Yes, your Honor.

22 **THE COURT:** All right. And the other question is:  
23 What is the -- I know what the effect is. We can push right  
24 ahead. The reëxam, I mean. What do you expect is going to  
25 happen in the reëxam?

1           **MR. WEINGAERTNER:** Well, your Honor, just a day or  
2 two ago, the Patent Office in the '720 Patent issued an Office  
3 Action. An Office Action rejected all of the patents that are  
4 in play over all of the references that were submitted. And so  
5 at some point within the next two months, Oracle, if at all,  
6 needs to respond either with argument that would be directly  
7 affecting claim construction; at least, on that patent.

8           And the other patents are all in play also. We're  
9 expecting rejections on those, because the Patent Office found  
10 substantial questions on all of them. So they're going to be  
11 trickling in; we don't know exactly when. And so it raises a  
12 serious issue about whether or not your Honor is construing in  
13 the absence of all of the intrinsic evidence that will  
14 ultimately be there.

15           **THE COURT:** Well, the intrinsic evidence is already  
16 there.

17           This is -- but there could be further admissions  
18 made. And, of course, the PTO might narrow some of the  
19 claims -- I don't know -- or invalidate them.

20           Mr. Jacobs, what do you say?

21           **MR. JACOBS:** I think if memory serves me, having read  
22 your Honor's orders, I believe your claim constructions have a  
23 certain provisional quality to them; that -- that if -- that  
24 you rule based on the best information available to the Court  
25 as of the moment; but if something comes up later that should

1 cause that to be upset, the Court understands that that may  
2 have to be revisited. I think --

3 **THE COURT:** Yes, I do have that language, but I  
4 expressly say the lawyers can't ask to revisit it. Never,  
5 never -- but I can on my own, because I've learned, after doing  
6 ten patent trials, that almost every one of them, I sit there  
7 thinking: I wish I had known that before I made that ruling.  
8 I would have done a little bit better job on the claim  
9 construction.

10 So I keep that little right for wiggle room, but if I  
11 don't say it expressly, then the lawyers will say, "Well, Judge  
12 you wanted to reconsider, so here's a new argument you didn't  
13 consider before."

14 So, no, you can't do that.

15 **MR. JACOBS:** We're not unhappy with holding claim  
16 construction in abeyance while the reëxaminations proceed.

17 **THE COURT:** But then the case would languish.

18 **MR. JACOBS:** No. The case would proceed. And at  
19 some point, we're going to have to take a snapshot of where we  
20 are. And Mr. Weingaertner and his client would re-brief, based  
21 on the intrinsic record that has been created between now and  
22 then.

23 The alternative is -- I mean, I think there's a  
24 technical point on which his argument is correct, which is that  
25 there is additional administrative record being developed. We

1 don't agree that there should be a stay.

2           We don't necessarily urge the Court to put it in  
3 abeyance and not rule on the basis of the record the Court has  
4 before it, but I think we have to give room for allowance that  
5 either side might point to the intrinsic record over the next  
6 few months that's developed in the reëxam and say, "See? We  
7 were really right all along."

8           **THE COURT:** Well, our trial date is in time. I have  
9 one law clerk that I want to dedicate to this case. And, come  
10 November or end of November, she'll be gone. So we are going  
11 to have this case on its way to the Federal Circuit before that  
12 happens. So I'm not going to wait.

13           Most likely, I rarely would stay it based on reëxam,  
14 but I won't say "Never." I would have to -- it would have to  
15 be a very good case that I would save some time. Otherwise, I  
16 have to have a brand new law clerk learn this. You know, look  
17 at all of these lawyers you have out there. You have the  
18 luxury of resources that I don't have. And then if -- you  
19 cannot imagine what a burden a case like this is, to try to  
20 learn it well enough. And then when my law clerk leaves, then  
21 I have to -- I'm on my own, and have to come back up to speed.  
22 There's a huge burden.

23           So I -- you -- this is a very real factor that I'm  
24 being candid with you about that most judges wouldn't admit to,  
25 but it's a real factor. So if I was you, I would be thinking:

1 Whether that judge is crazy and gets it right or not, some  
2 jury's going to be sitting over there, come October, hearing  
3 you all point to the code that says "symbolic reference" -- or  
4 vice versa; whatever it is. Both of you have good points to  
5 make. And you'll be able to make them to a jury.

6 And, of course, by this point, you'll be down to one  
7 or two claims, because no good trial lawyer would go to a jury  
8 with seven patents and 123 claims. You go with two claims.

9 **MR. JACOBS:** Understood, your Honor.

10 **THE COURT:** So you'd better start thinking of how  
11 you're going to prioritize it.

12 So by Monday at noon, you'll please let me know if  
13 you've agreed. Otherwise, you're going to wind up getting what  
14 I've come up with.

15 **MR. WEINGAERTNER:** Yes, your Honor.

16 **THE COURT:** I want to say all of you are great.  
17 You're brilliant. You did a great job, and I'm very happy to  
18 have you here.

19 Okay. I do have a criminal case coming up in five  
20 minutes. I need to ask you to let the marshals come in, and  
21 the lawyers come in. Thank you.

22 **MR. JACOBS:** Thank you, your Honor.

23 (At 3:05 p.m. the proceedings were adjourned)  
24  
25

**CERTIFICATE OF REPORTER**

I, LYDIA ZINN, Official Reporter for the United States Court, Northern District of California, hereby certify that the foregoing proceedings in C. 10-3561 WHA, Oracle America v. Google, Inc., were reported by me, a certified shorthand reporter, and were thereafter transcribed under my direction into typewriting; that the foregoing is a full, complete and true record of said proceedings as bound by me at the time of filing.

The validity of the reporter's certification of said transcript may be void upon disassembly and/or removal from the court file.

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/s/ Lydia Zinn, CSR 9223, RPR

Monday, April 25, 2011